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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,650	04/19/2000	Paul Bucknell	PHB 34,339	2839
24737	7590	05/24/2004	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			YUN, EUGENE	
			ART UNIT	PAPER NUMBER
			2682	19

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/552,650

Applicant(s)

BUCKNELL ET AL.

Examiner

Eugene Yun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-16 is/are allowed.
- 6) ☐ Claim(s) 2-4, 9 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/17/2004 has been entered.

### ***Election/Restrictions***

2. Newly amended claim 8 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 8 has been amended into independent form and is directed to memory and functions of memory in a software interface, which is a subcombination of the rest of the independent claims, which are directed to the configuring of two communication terminals in order to enable communication between the two.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 8 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 2-4, 9, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Blakeney, II et al. (US 6,421,374).

Referring to Claim 2, Blakeney teaches a method of establishing a communications link between a mobile and a fixed terminal, the method comprising:

said mobile terminal transmitting a message notifying the fixed terminal of key parameters relating to its operational capabilities (see col. 8, lines 35-37);

the fixed terminal receiving the message, selecting which key parameters it requires to be supplied by the mobile terminal in order to have the capability of communication with the mobile terminal (see col. 9, lines 17-22);

informing the mobile terminal of the key parameters it needs in order to be able to establish a communication link (see col. 9, lines 17-22); and the mobile terminal

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transferring the data relating to the required key parameters to the fixed terminal in order to configure/reconfigure the fixed terminal to be able to communicate with the mobile terminal (see col. 9, lines 42-49 noting that suggesting an alternative service configuration and accepting the alternative service configuration can be considered as teaching the last two limitations above)(also note that according to the cited paragraph in col. 8, communication and configuration can go in either direction).

Claim 17 has similar limitations to Claim 2.

Referring to Claim 9, Blakeney teaches a fixed terminal for use in a communication system in which a mobile terminal can configure said fixed terminal by service negotiation, the fixed terminal comprising a transceiver 4 (fig. 1), a memory for storing software functions (see col. 8, lines 43-45), and a processor for controlling operation of the fixed terminal in accordance with stored software functions (see col. 8, lines 40-43), at least one of the software functions being alterable in response to the receipt of a message from said mobile terminal containing new software function (see col. 8, lines 46-48) plus interface software required by the processor in building the new function into an actual implementation on the fixed terminal (see col. 8, lines 54-59).

Referring to Claim 3, Blakeney also teaches the mobile terminal transmitting the required function plus software required in building a new function into an actual implementation on the fixed terminals (see col. 8, lines 54-59).

Referring to Claim 4, Blakeney also teaches testing the air interface to ensure that configuring has taken place without error (see col. 13, lines 4-8).

***Allowable Subject Matter***

5. Claims 10-16 are allowed.

Regarding Claim 10, Blakeney, BT, Nodoushani, Trompower, and Morris do not teach, alone nor in combination, the combination of transmitting capabilities to another terminal, receiving parameters, said parameters matching said capabilities, selecting a portion of said parameters to form selected parameters and informing said another terminal of said selected parameters, and transmitting required information to form a profile based on said selected parameters.

***Response to Arguments***

6. Applicant's arguments with respect to claims 2-4, 9 and 17 have been considered but are moot in view of the new ground(s) of rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Eugene Yun  
Examiner  
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5/17/04